

REMARKS

The allowance of claims 1-4 is acknowledged.

By the above Amendment, the status of the parent application has been updated and claim 5 has been amended to recite a feature corresponding to that recognized by the Examiner as not being taught or suggested in the prior art. More particularly, the Examiner in the indication of allowable subject matter recognized that the prior art does not teach nor suggest in combination with the above limitations "a common line electrically connected to said first and second protection element lines..." By the present Amendment, claim 5 has been amended to recite the feature of a common line electrically connected to said first and second protection element lines, noting that claim 5 does not recite the feature of "by third high-resistance elements" as recited in claim 1.

Turning to the rejection of claims 5-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,184,948 in view of U.S. Reissue Patent RE38,292, this rejection is traversed insofar as it is applicable to the present claims and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not

a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

In setting forth the rejection based upon U.S. Patent 6,184,948, the Examiner indicates that this patent discloses first and second protection element lines which the patent describes as "shorting bars" as described in column 8, lines 21-28 of this patent as follows:

Furthermore, the shorting bars for detecting an error in the gate and the source lines are divided into two kinds. The first is for the odd lines, the second is for the even lines. As a result, the shorting bar can detect a shorting errors when neighboring lines are shorted by each other. Consequently, the present invention suggests a manufacturing method in which manufacturing process is simplified and enhanced error detection elements are provided.

Applicants note that by the present invention, independent claim 5 has been amended to recite a common line electrically connected to the first and second protection element lines. Applicants note that in accordance with the disclosure and teaching of U.S. Patent 6,184,948, for inspecting for shorting errors, the odd lines and the even lines are divided into two kinds, and Applicants submit that if the odd lines and even lines are electrically connected with a common line, as now recited in claim 5, a short-circuit error which is to be detected in such patent is not detectable. Thus, U.S. Patent 6,184,948 not only fails to disclose a common line connected in the manner set forth in claim 5, as amended, but it cannot be considered obvious in the sense of 35 U.S.C. § 103 to adopt such structure by modification of U.S. Patent No. 6,184,948 since it would be contrary to the disclosure and teachings of such patent. See In re Fine, supra. Accordingly, Applicants submit that claim 5 and the dependent claims, as amended patentably distinguish over U.S. Patent 6,184,948 taken alone or in combination with U.S. Reissue Patent RE38292. Accordingly, Applicants submit that claims 5-8, should now be considered to be in condition for allowance.

Applicants note that the Examiner recognizes that the art also fails to teach a second substrate with LC interposed but contends that such would be inherent or

well known and obvious to provide. Applicants submit that this position by the Examiner is improper as is apparent from the decision of In re Lee, supra. Furthermore, such position does not overcome the deficiency with regard to a common line as now recited in claim 5 and therewith the dependent claims.

Likewise, with respect to the disclosure and teaching of U.S. Reissue Patent RE38292, irrespective of the Examiner's position with respect thereto, such patent does not overcome the deficiencies of U.S. Patent 6,184,948 and the proposed combination fails to provide the recited claim 5 features of claim 5 and the dependent claims. Accordingly, all claims should be considered allowable over this proposed combination of references.

In view of the above amendments and remarks, Applicants submit that all claims present in this application should now be in condition for allowance and issuance of an action of a favorable nature is courtesly solicited.

If the Examiner believes that there are any other points which may be clarified or otherwise disposed of either by telephone discussion or by personal interview, the Examiner is invited to contact Applicants' undersigned attorney at the number indicated below.

To the extent necessary, Applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Antonelli, Terry, Stout & Kraus,


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LLP Deposit Account No. 01-2135 (Docket No. 501.37281CC2), and please credit any excess fees to such Deposit Account.

Respectfully submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

By _____
Melvin Kraus
Reg. No. 22,466

MK/dlt

1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209
Telephone: (703) 312-6600
Facsimile: (703) 312-6666